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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/664,288	09/17/2003	L. Mercer McKinley	101896-206 (DEP5129)	4546	
21125	7590	08/25/2008	EXAMINER		
NUTTER MCCLENNEN & FISH LLP WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604			ARAJ, MICHAEL J		
ART UNIT			PAPER NUMBER		
3733					
NOTIFICATION DATE			DELIVERY MODE		
08/25/2008			ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@nutter.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/664,288	MCKINLEY, L. MERCER
	<b>Examiner</b>	<b>Art Unit</b>
	MICHAEL J. ARAJ	3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 01 May 2008.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,4-6,8-12 and 14-16 is/are pending in the application.
- 4a) Of the above claim(s) 4,6,11 and 15 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,2, 5,8-10,12,14 and 16 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2, 5 and 8-10,are rejected under 35 U.S.C. 102(b) as being anticipated by Hayes et al. (U.S. Patent No. 5,020,519).

Hayes et al. disclose a spinal rod approximator system(Fig. 6) comprising a spinal implant (2) having a rod-receiving member; and a spinal rod approximator having an implant-gripping member (14) having a u-shaped distal portion (see Figure 2 below) that extends in a direction substantially transverse to a longitudinal axis (A) of a proximal portion of the implant-gripping member, where the distal portion includes opposing legs (44, 46) extend under a distal end of the rod receiving member of the spinal implant (2) formed on a substantially planar U-shaped distal portion; a rod-engaging member (83) slidably coupled to the implant-gripping member along the longitudinal axis of the proximal portion at a position proximal to the implant-gripping member, comprising of opposed arms (86) each having a rod-receiving recess (88), slidably coupled to the implant-gripping member along the longitudinal axis of the proximal portion at a position proximal to the implant-gripping member, the rod-engaging member having a distal portion that extends transverse to a proximal portion (see Fig. 4); and a pusher member (73) freely-rotatably coupled to at least one of the

implant-gripping member and the rod-engaging member and threadably mated to the other one of the implant-gripping member and the rod-engaging member such that the rotation of at least a portion of the pusher member is effective to move at least one of the implant-gripping member and the rod-engaging member with respect to one another. The pusher member comprises a threaded rod extending through a threaded bore formed in a portion of the implant-gripping member, and wherein the threaded rod includes a distal end mated to a portion of the rod-engaging member and includes a handle member. The rod-engaging and implant-gripping members are offset from the sliding axis (as seen in Fig. 1 below).

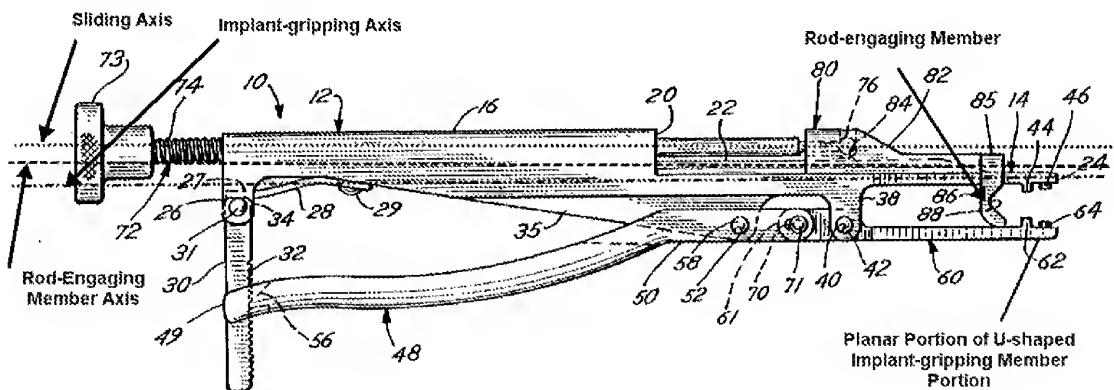
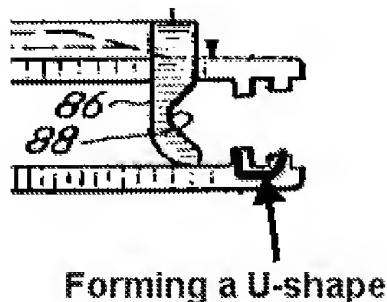


Figure 1 (taken from '519)



**Figure 2 (enlarged portion of Figure 1)**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayes et al. (U.S. Patent No. 5,020,519).

Hayes et al. disclose the claimed invention except for the opposed legs of the u-shaped distal portion extending outward from the implant-gripping portion have the same axial height on the implant gripping portion. It would have been an obvious to one skilled in the art at the time the invention was made to have made the opposed legs of equal length, since it is only a matter of design choice and would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

***Response to Arguments***

Applicant's arguments filed May 1, 2008 have been fully considered but they are not persuasive. Applicant argues that Hayes et al. does not disclose a u-shaped distal portion that includes opposed legs that extend under a distal end of a rod-receiving member of the spinal implant. Firstly, the U-shaped distal portion can be better seen in Figure 2 above. Secondly, depending on how one establishes a distal end of the rod-receiving will clearly show how Hayes et al. reads on the pending claims. Looking at Figure 6, the arrow labeled as 60 can be considered the distal end of the rod-receiving member of the spinal implant. With this definition it is apparent that Hayes et al. does teach a u-shaped distal portion that includes opposed legs that extend under a distal end of a rod-receiving member of the spinal implant.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. ARAJ whose telephone number is (571)272-5963. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael J Araj/  
Examiner, Art Unit 3733  
/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733

<b>Application Number</b> 	Application/Control No.	Applicant(s)/Patent under Reexamination
	10/664,288 <b>Examiner</b> MICHAEL J. ARAJ	MCKINLEY, L. MERCER <b>Art Unit</b> 3733